

REMARKS

Favorable reconsideration and allowance of the claims of the present application are respectfully requested.

Applicants observe that this Amendment and RCE filing are submitted in lieu of filing an Appeal Brief. Applicants note, in this regard, that in response to the Final Rejection dated November 3, 2003, a Notice of Appeal and a Petition for three-month extension of time were filed on May 3, 2004. Applicants observe that their return postcard including this submission was date stamped May 6, 2004 by the United States Patent and Trademark Office. Hence, the time period for responding to the Notice of Appeal is July 6, 2004.

In the Final Rejection dated November 3, 2003, Claim 4 was rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description or enablement requirement. Specifically, the Examiner alleges that the originally filed speciation does not provide support for a combination of a nucleic acid and a protein. Although applicants note the in original Claim 4 the terminology “and/or” was used which means that the binding partner could be a protein or a nucleic acid molecule or a combination thereof, applicants have amended Claim 4 in the manner indicated supra. Applicants observe that this amendment was performed to advance prosecution of the instant application and does not mean that the present invention does not consider the use of a binding partner that constitutes a combination of a protein and a nucleic acid. Instead, the originally filed application, particular Claim 4, provides support for the use of such a combination.

Applicants respectfully submit that the above amendment to Claim 4 obviates the 35 U.S.C. § 112, first paragraph, rejections raised in the Final Office Action dated November 3, 2003. Reconsideration and withdrawal thereof are thus respectfully requested.

Applicants acknowledge, with thanks, the Examiner's remarks made in the Final Rejection indicating the allowability of Claims 8, 9, 12 and 27. Despite this indication of allowable subject matter, applicants believe that broader patent protection for the instant invention is available. Hence, applicants have not amended the claims to include the allowable features recited in the above-mentioned claims. Instead, applicants have amended Claim 1 to positively recite a method for detecting a toxicant of interaction between two or more binding partners *in an aquatic, terrestrial, gaseous or industrial environmental sample*. Support for the italicized feature added to Claim 1 is found at Page 7, lines 28-31 of the specification of the instant application. Since the above amendment to Claim 1 does not introduce new matter into the subject specification, entry thereof is respectfully requested.

Applicants observe that, in the Final Rejection, Claims 1, 3, 4, 5, 6, 7 and 11 were rejected under 35 U.S.C. § 102 (e) as allegedly anticipated by U.S. Patent No. 6,207,391 to Wu, et al. ("Wu, et al.").

Concerning the anticipation rejection, it is axiomatic that anticipation under § 102 requires that the prior art reference disclose each and every element of the claim to which it is applied. In re King, 801 F.2d, 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1996). Thus, there must be no differences between the subject matter of the claim and the disclosure of the prior art reference. Stated another way, the reference must contain

within its four corners adequate direction to practice the invention as claimed. The corollary of the rule is equally applicable: Absence from the applied reference of any claimed element negates anticipation. Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986).

Wu, et al. do not anticipate the claimed method since the applied reference does not teach a method for the identification of a toxicant in an aquatic, terrestrial, gaseous or industrial environmental sample, as presently claimed. The disclosure of Wu, et al. is directed to a method for identifying agents that modulate the interaction of two specific polypeptides (specifically, STAT4 and STAT6) with their respective cellular receptors. Nowhere in the document of Wu, et al. is it disclosed that the putative inhibitors of STAT4 or STAT6 are toxicants that are present in an aquatic, terrestrial, gaseous or industrial environmental sample. In accordance with Wu, et al., the disclosed method is amendable to high-throughput drug screening protocols. See Col. 4, lines 39-44. Furthermore, there is no suggestion that an assay based on the interaction of STAT4 or STAT6 with their respective cellular receptors would have any utility as a method for detecting an environmental toxicant. In Wu, et al., the disclosed purpose of screening for agents that modulate the interaction of STAT4 or STAT6 with their respective receptors (binding partners), is to identify therapeutic compounds. Applicants respectfully submit that compounds such as this are distinct from environmental toxicants, which could arguably be considered diametrically opposed to a therapeutic compound.

Accordingly, applicants respectfully submit that the anticipation rejection based on the disclosure of Wu, et al. has been obviated. Reconsideration and withdrawal of the rejection to Claims 1, 4, 5, 6, 7 and 11 under 35 U.S.C. § 102(e) citing Wu, et al. are respectfully requested.

The foregoing remarks clearly demonstrate that the applied reference does not teach each and every aspect of the claimed invention, as required by King and Kloster Speedsteel; therefore the claims of the present application are not anticipated by the disclosure of Wu, et al. Applicants respectfully submit that the instant § 102 rejection has been obviated and withdrawal thereof is respectfully requested.

Thus, in view of the foregoing amendments and remarks, it is firmly believed that the present case is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,

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